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09/805,157	03/14/2001	Hajime Matsubara	26.1699	1765
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STAAS & HALSEY LLP JIM LIVINGSTON SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/805,157

Applicant(s)

MATSUBARA, HAJIME

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-5 and 7-18 have been examined.

#### ***Response to Amendment***

2. The Amendment filed on 5/30/06 is insufficient to overcome the prior rejection.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/30/06 has been entered.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7, 9-12, 14-17, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haituka (6,366,298) in view of Cohen (6,236,330) and in further view of McGregor (5,250,941).

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Claim 1, 7, 12, 18: Haitsuka discloses a method, medium transmitting advertising information, comprising:

receiving position information from a client (col 5, line 59-col 6, line 4; col 6, lines 42-45);

determining a passage count of the client in a predetermined advertising information transmission area in which the position information belongs and storing the passage count; and transmitting to the client advertising information according to the passage count of the client in the transmission area (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user

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frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Haitsuka further discloses that the client can be mobile (col 4, lines 12-30).

Haitsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a users sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).

Haitsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Additionally, Haitsuka discloses tracking a user geographically and that a variety of rules can be utilized for determining to send advertising (Fig. 3).

Haitsuka further discloses changing advertisements after certain periods of time (col 2, lines 48-50) and recording what advertisements a user was exposed to, for how long, when, etc (col 2, lines 62-67) and controlling the frequency of which a user sees an advertisement (col 6, lines 17-27).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize user exposure to advertising or time duration of exposure as a parameter of whether to show a user new advertising or not. One would have

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been motivated to do this in order to better control the amount of exposure a user receives to particular advertisements.

Also, Haitsuka discloses changing advertisements after certain periods of time, adjusting content based on frequency, maximum views by an individual, time periods, time frames, profiles, and geographic information:

“(12) Sophisticated systems have the capability to change the advertisement after a certain period of time” (col 2, lines 47-50);

(19) The data to be sent to users preferably has scheduling requirements that dictate when it should be sent. These scheduling requirements may include, for example: frequency, maximum number of times to send to an individual, minimum number of times to send to an individual, time of day to send, and first and last days to send. The data to be sent to users can have demographic requirements that dictate to whom it should be sent. These include (but are not limited to): personal profile, interactive data, network usage information and geographic location” (col 6, lines 17-29).

McGregor (5,250,941) discloses tracking and counting a mobile user's passing through a predetermined area over a certain time frame (col 1, lines 5-25; col 2, lines 5-11; col 2, line 64- col 3, line 7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Haitsuka can utilize geographic area information or user frequency in a geographic area in a certain time period as criteria for transmission of advertising.

Therefore, it would be obvious that Haitsuka would only send one advertisement to the user for a certain time period for a certain location/region. One would have been motivated to do this in

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order to provide appropriate or optimal amounts of targeted advertising to users without oversaturating the user with the same advertisement.

Additionally, Examiner notes that claim 1 is interpreted as the passage count equaling zero or one for the specified time period. That is, as claim 1 is written, the passage count is always zero or one since the passage count of two or more are disregarded. The predetermined area and the predetermined time period vary. However, the passage count is always zero or one. Also, as stated in Claim 1, the passage count is utilized to determine whether or how much advertising to send to the user. Claim 1 states, “transmitting to the mobile client advertising information according to the passage count of the mobile client. . .”. Hence, claim 1 is interpreted as stating that if a mobile client passes thru a predetermined area during a predetermined time period the mobile client is sent a maximum of one advertising information for the designated time period.

And, Examiner notes that it is the combination of Haitsuka and McGregor which renders obvious the Applicant’s claimed features of sending a maximum of 1 piece of advertising information in a given time period to a user who passes thru a predetermined area in the given time period.

Also, Examiner notes that the claim 1 could be interpreted as the Applicant has stated on page 8 and in the quote above. However, the claim states one predetermined period of time. That is, the claims do not necessitate a predetermined period of time such as 5 minutes and a second larger time period such as 25 minutes. That is, there is only one predetermined period of time stated in claim 1. Hence, the predetermined period of time could be the same as the entire

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period over which the passage count is taken. That is, the predetermined period of time could be 25 minutes and the entire period over which the passage count is taken can be 25 minutes. The claims do not state that the passage count is a continuous counter for a time period that is greater than the predetermined period of time. Hence, the combination of the prior art renders obvious a passage count over a predetermined period of time where the passage count is not incremented over one for that predetermined period of time.

Examiner notes that the prior art above discloses that the passage count above is within the predetermined period of time.

Also, the combination of the prior art renders obvious the features of a fee for distributing advertising information throughout the predetermined advertising information transmission area is determined based on an amount of traffic in the predetermined advertising information transmission area, a time period in which the advertising information is distributed, or attributes of the predetermined advertising information transmission area in which the advertising information is distributed.

Examiner notes that as the claims are written, a fee for distributing advertising information throughout the advertising information transmission area can be determined based on any of the factors stated in the paragraph preceding.

And, Haituka discloses charging for advertising based on certain time periods:

“(19) The data to be sent to users preferably has scheduling requirements that dictate when it should be sent. These scheduling requirements may include, for example: frequency, maximum number of times to send to an individual, minimum number of times to send to an individual, time of day to send, and first and



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last days to send. The data to be sent to users can have demographic requirements that dictate to whom it should be sent. These include (but are not limited to): personal profile, interactive data, network usage information and geographic location (col 6, lines 17-28);

Moreover, advertisers prefer to pay for advertising based upon the number of relevant consumers who are actually exposed to the advertisement. For typical on-line systems and networks, including the Web, it is often difficult for an advertiser to precisely determine whether its advertisements were actually viewed by a user and for how long, and whether the advertisement induced a response. Accordingly, there exists a need for a targeted advertisement system that also can provide information as to the characteristics of those who were exposed to each advertisement, for how long the user was exposed, and at what times“ (col 2, lines 55-67) .

Haitsuka further discloses varying fees charged to advertiser based on different factors (col 2, lines 40-63).

Cohen further discloses charging for advertising to a predetermined area based on a variety of different factors including time period, attributes of the area such as density for that area, and other factors related to the area:

“The message is displayed pursuant to a schedule which includes date, time of day and display duration while the display is within the zone or until the display is located in another zone which is not included within the message schedule. A tiered system control network includes a plurality of fixed stations which transmit message content and scheduling data to the controller and which generate billing and other accounting records (Abstract);

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(6) Advertising was known to be time and location sensitive. Among the disadvantages heretofore encountered with visual displays has been the inability to efficiently deliver the intended message to a target audience in desired geographic zones and specified time slots so that advertising revenues could be maximized in accordance with the value delivered. (col 1, lines 27-34)

(9) Similarly, business which desired to attract children, e.g. amusement parks, did not wish to bear costs associates with mobile billboard displays when their target customers were not available, e.g. during the times of day when children were in school or in the late evening.

(10) There was a further need to target precise visual messages directed to a particular location and time of day at minimal expense.

(11) The advertiser's needs with respect to receiving advertising billing which reflected specific desired dates, times of day, duration of display, specific locale wherein the advertiser's message was displayed were also unfulfilled (col 1, lines 44-56);

(17) The stations 20, 22, 24 process the current status data to monitor display density, i.e. number of displays each zone, and will communicate with the controllers to display alternate messages if the transporter density displaying a selected message is greater than specified. The stations also process the transaction records to generate periodic advertiser billing which identifies the displayed message, the physical locations wherein such message was displayed, the dates and times, and monitored parameters and the charges

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due based upon the appropriate billing rates (which can vary based upon location, time of day, monitored parameters, and density). The advertiser billing is transmitted to an advertiser 28 via conventional mail, E-mail, facsimile or other means (col 5, lines 20-33).

(19) The fixed location stations 20, 22 and 24 may also be in communication with a master control base 32 which receives the transaction data and billing data, accesses memory stored customer profiles and serves an overseeing function which includes analysis of the transaction and billing records, revision of fee schedules, revision of physical zone definitions and disaster recovery functions for the stations” (col 5, lines 38-46).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Cohen’s other factors by which to charge for advertising to Haitsuka’s different factors by which to charge for advertising. One would have been motivated to do this in order to more appropriately charge for relevant advertising.

Claim 2: Haitsuka and Cohen and McGregor disclose the method according to claim 1. Haitsuka further discloses that the advertising information according to the passage count of the client in the transmission area is transmitted to the client in response to reception from the client of a request to transmit advertising information (col 4, lines 52-56).

Claim 3: Haitsuka and Cohen and McGregor disclose the method according to claim 1.

Haitsuka does not explicitly disclose that the advertising information is transmitted when the passage count of the client has reached a predetermined value.

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However, Haitsuka discloses monitoring user activities including geographic activity, that the advertiser can utilize a wide range of criteria for sending advertising (Fig. 3; col 6, lines 13-28), and that the frequency of advertisements can be set (col 6, lines 13-28).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Haitsuka can make user visits to a certain area a criteria for sending advertisements. One would have been motivated to do this in order to target users who are often in a certain area.

Claim 4: Haitsuka and Cohen and McGregor disclose the method according to claim 1. Haitsuka does not explicitly disclose that neighboring transmission areas are set up to overlap each other, and, in the overlapping portion of the transmission areas, advertising information according to the passage count of the client in each of the overlapping transmission areas is transmitted in accordance with predetermined rules.

However, Cohen discloses that neighboring transmission areas are set up to overlap each other, and, in the overlapping portion of the transmission areas, advertising information according to the passage count of the client in each of the overlapping transmission areas is transmitted in accordance with predetermined rules (col 5, lines 45-52; col 1, lines 34-39; col 1, lines 52-56).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Cohen's overlapping zones with advertising to Haitsuka's targeting advertising geographically to a user. One would have been motivated to do this in order to provide a range of advertisements for different areas or overlapping areas.

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Claim 9: Haitsuka and Cohen and McGregor disclose the method according to claim 1, and Haitsuka further disclose that the transmission area is divided in transmission time periods, and a different piece of advertising information to be transmitted to the client in the transmission area is registered for each transmission time period (col 2, lines 48-50; col 6, lines 17-27).

Claim 10: Haitsuka and Cohen and McGregor disclose the method according to claim 9, and Haitsuka further disclose that different pieces of advertising information according to the transmission area and the transmission time periods are transmitted to the client (col 2, lines 50-60; Fig. 3, item 140f).

Claim 11: Haitsuka and Cohen and McGregor disclose the method according to claim 10, and Haitsuka further disclose that when the client is passing through the transmission area, advertising information according to the passage count in the corresponding the transmission time period is transmitted to the client (Fig. 3).

Claim 14, 15: Haitsuka discloses a method, medium receiving advertising information, medium comprising:

transmitting position information of a client sequentially to a server (col 5, line 59-col 6, line 4; col 6, lines 42-45);

receiving from the server advertising information according to the count of passage through that transmission area at that time, when passing through an advertising information transmission area in which the position information belongs (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Hairsuka further discloses that the client can be mobile (col 4, lines 12-30).

Haitsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a users sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).

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Haitsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area in a certain time period as criteria for transmission of advertising. One would have been motivated to do this in order to provide appropriate or optimal amounts of targeted advertising to users.

Also, please see the rejection of claims 1, 7, 12, 18 above for a full analysis of the use of the McGregor reference.

Claim 16: Haitsuka discloses a method receiving advertising information, comprising:  
transmitting position information of a client sequentially to a server (col 5, line 59-col 6, line 4; col 6, lines 42-45);  
transmitting a request for transfer to the server (Fig. 3);  
receiving the count of passage through a transmission area for the advertising information at the time of transmission of the transfer request or corresponding incentive information to the passage count (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); and

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storing the received passage count or incentive information on a portable external storage medium (col 4, lines 13-20).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Hairsuka further discloses that the client can be mobile (col 4, lines 12-30).

Haitsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a users sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).



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Haitsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user frequency in a geographic area in a certain time period as criteria for transmission of advertising. One would have been motivated to do this in order to provide appropriate or optimal amounts of targeted advertising to users.

Also, please see the rejection of claims 1, 7, 12, 18 above for a full analysis of the use of the McGregor reference.

5. Claim 5, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka (6,366,298) in view of Cohen (6,236,330) in further view of McGregor (5,250,941) and in further view of Bandera (6,332,127).

Claim 5, 13: Haitsuka discloses a method transmitting advertising information, comprising:

setting up conditions assigning targeted advertising and advertising information in a predetermined advertising information transmission area (col 2, lines 50-60);

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receiving position information from a number of clients (col 5, line 59-col 6, line 4; col 6, lines 42-45);

determining the state of passage of each of the clients in the transmission area in which the position information from the clients belong (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); and

assigning the advertising information to the client or clients that meet the conditions on the basis of the state of passage (col 2, lines 50-60; Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user

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frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Haitsuka does not explicitly disclose incentives distinct from advertising.

However, Bandera further discloses incentives distinct from advertising (col 3, lines 19-42).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Bandera's incentives and advertising to Haitsuka's advertising for promotional purposes. One would have been motivated to do this in order to keep better track of different types of advertising and the response to different types of advertising.

Hairsuka further discloses that the client can be mobile (col 4, lines 12-30).

Haitsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a user sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).

Haitsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haitsuka can utilize geographic area information or user

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frequency in a geographic area in a certain time period as criteria for transmission of advertising. One would have been motivated to do this in order to provide appropriate or optimal amounts of targeted advertising to users.

Also, please see the rejection of claims 1, 7, 12, 18 above for a full analysis of the use of the McGregor reference.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haituka (6,366,298) in view of Cohen (6,236,330) in further view of McGregor (5,250,941) and in further view of Gough (6,360,221).

Claim 8: Haituka and Cohen and McGregor disclose the method according to claim 1.

Haituka further discloses fees and user control over content (col 2, lines 35-41; col 4, lines 53-56).

Haituka does not explicitly disclose that the transmission of advertising information to the client is omitted as instructed by the client.

However, Gough discloses that the transmission of advertising information to the client is omitted as instructed by the client (col 6, lines 30-36).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gough's omission of advertisements to Haituka's user control of content. One would have been motivated to do this in order to provide better user control over user paid services.

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7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haitsuka (6,366,298) in view of Cohen (6,236,330) in further view of McGregor (5,250,941) and in further view of Eggelston (6,061,660).

Claim 17: Haitsuka discloses a method receiving advertising information, comprising: receiving a transmission management database which defines transmission criteria for advertising information (Fig. 3, 140c); retrieving from the database a count of passage through the transmission area through which it is passing based on position information of a client, and storing the count of passage (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); transmitting to the server a request for transmission of advertising information and the passage count (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5); and receiving from the server advertising information according to the passage count in the transmission area at time of the transmitting (Fig. 3; col 3, lines 60-65; col 5, lines 27-44; col 5, lines 59-col 6, line 4; col 6, lines 24-34; col 7, lines 2-5).

Haitsuka further discloses tracking what advertisements a user was exposed, how many exposures a user was presented, and the frequency of exposure to advertisements (col 2, lines 62-67; col 6, lines 17-27).

Haitsuka does not explicitly disclose defining transmission areas.

However, as disclosed above in the prior art references, Haitsuka discloses tracking and recording a variety of user information including demographic, profile, and geographic information including specific user location or the general user location. Haitsuka further

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discloses that a variety of criteria can be utilized for determining whether to send advertising to a user, including geographic criteria in many forms.

Additionally, Cohen discloses defining transmission areas and the utilization of advertising (col 1, line 60-col 2, line 17; Fig. 2; Fig. 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Hairsuka can utilize geographic area information or user frequency in a geographic area as criteria for transmission of advertising. One would have been motivated to do this in order to provide advertising of location convenient interest to a user.

Eggleston further discloses the utilization of awards points as an incentive and related to advertising purposes.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Eggleston's utilization of points to Hairsuka's advertising. One would have been motivated to do this in order to entice regular users.

Hairsuka further discloses that the client can be mobile (col 4, lines 12-30).

Hairsuka further discloses recording the number of times a user sees an advertisement (col 2, lines 55-60) and recording the frequency or number of times a users sees an advertisement and that geographic location can be a requirement for whether the user sees an advertisement (col 6, lines 17-27).

Hairsuka further discloses tracking user location, profile, demographics, interactive data, scheduling requirements (col 3, lines 60-65) and that this information can be utilized for sending information (col 5, lines 30-44; col 6, lines 24-29).

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Cohen discloses geographic zones for advertising (col 1, lines 27-40 and as cited above) and that the number of displays of an advertisement in a predefined geographic zone is recorded (col 5, lines 20-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Haituka can utilize geographic area information or user frequency in a geographic area in a certain time period as criteria for transmission of advertising. One would have been motivated to do this in order to provide appropriate or optimal amounts of targeted advertising to users.

Also, please see the rejection of claims 1, 7, 12, 18 above for a full analysis of the use of the McGregor reference.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-5, and 7-18 have been considered but are not found persuasive.

On page 8 of the Applicant's Remarks dated 5/30/2006, Applicant states that, "For example, a user could obtain a maximum passage count of fine in a 25 minute period."

Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Also, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). And, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

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Indeed, the claim 1 could be interpreted as the Applicant has stated on page 8 and in the quote above. However, the claim states one predetermined period of time. That is, the claims do not necessitate a predetermined period of time such as 5 minutes and a second larger time period such as 25 minutes. That is, there is only one predetermined period of time stated in claim 1. Hence, the predetermined period of time could be the same as the entire period over which the passage count is taken. That is, the predetermined period of time could be 25 minutes and the entire period over which the passage count is taken can be 25 minutes. The claims do not state that the passage count is a continuous counter for a time period that is greater than the predetermined period of time. Also, the claims do not state that there is more than one predetermined period of time within a monitored period or that the predetermined period of time keeps repeating. Also, the claims do not state whether the passage count resets or not at any point. Hence, the combination of the prior art renders obvious a passage count over a predetermined period of time where the passage count is not incremented over one for that predetermined period of time.

Also, the Applicant has added the features, “a fee for distributing advertising information throughout the predetermined advertising information transmission area is determined based on an amount of traffic in the predetermined advertising information transmission area, a time period in which the advertising information is distributed, or attributes of the predetermined advertising information transmission area in which the advertising information is distributed” to the independent claims.



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Examiner notes that as the claims are written, a fee for distributing advertising information throughout the advertising information transmission area can be determined based on any of the factors stated in the quote above.

And, Haitsuka discloses charging for advertising based on certain time periods:

“(19) The data to be sent to users preferably has scheduling requirements that dictate when it should be sent. These scheduling requirements may include, for example: frequency, maximum number of times to send to an individual, minimum number of times to send to an individual, time of day to send, and first and last days to send. The data to be sent to users can have demographic requirements that dictate to whom it should be sent. These include (but are not limited to): personal profile, interactive data, network usage information and geographic location (col 6, lines 17-28);

Moreover, advertisers prefer to pay for advertising based upon the number of relevant consumers who are actually exposed to the advertisement. For typical on-line systems and networks, including the Web, it is often difficult for an advertiser to precisely determine whether its advertisements were actually viewed by a user and for how long, and whether the advertisement induced a response. Accordingly, there exists a need for a targeted advertisement system that also can provide information as to the characteristics of those who were exposed to each advertisement, for how long the user was exposed, and at what times” (col 2, lines 55-67).

Haitsuka further discloses varying fees charged to advertiser based on different factors (col 2, lines 40-63).

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Cohen further discloses charging for advertising to a predetermined area based on a variety of different factors including time period, attributes of the area such as density for that area, and other factors related to the area:

“The message is displayed pursuant to a schedule which includes date, time of day and display duration while the display is within the zone or until the display is located in another zone which is not included within the message schedule. A tiered system control network includes a plurality of fixed stations which transmit message content and scheduling data to the controller and which generate billing and other accounting records (Abstract);

(6) Advertising was known to be time and location sensitive. Among the disadvantages heretofore encountered with visual displays has been the inability to efficiently deliver the intended message to a target audience in desired geographic zones and specified time slots so that advertising revenues could be maximized in accordance with the value delivered. (col 1, lines 27-34)

(9) Similarly, business which desired to attract children, e.g. amusement parks, did not wish to bear costs associates with mobile billboard displays when their target customers were not available, e.g. during the times of day when children were in school or in the late evening.

(10) There was a further need to target precise visual messages directed to a particular location and time of day at minimal expense.

(11) The advertiser's needs with respect to receiving advertising billing which reflected specific desired dates, times of day, duration of display,

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specific locale wherein the advertiser's message was displayed were also unfulfilled (col 1, lines 44-56);

(17) The stations 20, 22, 24 process the current status data to monitor display density, i.e. number of displays each zone, and will communicate with the controllers to display alternate messages if the transporter density displaying a selected message is greater than specified. The stations also process the transaction records to generate periodic advertiser billing which identifies the displayed message, the physical locations wherein such message was displayed, the dates and times, and monitored parameters and the charges due based upon the appropriate billing rates (which can vary based upon location, time of day, monitored parameters, and density). The advertiser billing is transmitted to an advertiser 28 via conventional mail, E-mail, facsimile or other means (col 5, lines 20-33).

(19) The fixed location stations 20, 22 and 24 may also be in communication with a master control base 32 which receives the transaction data and billing data, accesses memory stored customer profiles and serves an overseeing function which includes analysis of the transaction and billing records, revision of fee schedules, revision of physical zone definitions and disaster recovery functions for the stations” (col 5, lines 38-46).

Examiner notes that the citations in this Response to Arguments section have also been added to the rejection above.

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The following is in response to the Applicant's arguments on page 10 concerning the motivation to combine the prior art.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to. Also, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Also, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Additionally, in the MPEP section 716.01(c) under the title "Attorney Arguments Cannot Take the Place of Evidence", note that objective evidence must be presented to prove inoperability.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that the prior art is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Haitsuka, Cohen, and McGregor involve tracking and targeting a user for content/advertising where the user can be mobile or have varying geographic locations and factors such as time, frequency, location, etc can be considered for more optimal targeting. Hence, Haitsuka, Cohen, and McGregor are relevant to each other and provide relevant features to each other for better tracking and targeting of a mobile user for advertising purposes.

Hence, the combination of the prior art renders obvious the features of the Applicant's claims and there is motivation to combine the prior art.

### ***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art

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of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Arthur Duran  
Primary Examiner  
6/15/2006